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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,208	03/09/2001	Toshiyuki Moritsu	10721-9US	8571
24956 7590 09/21/2007 MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			EXAMINER KESACK, DANIEL	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 09/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/803,208	Applicant(s) MORITSU ET AL.	
	Examiner Dan Kesack	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-16,18-21 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-16,18-21 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Amendment filed June 21, 2007 has been entered and fully considered. Claims 1, 2, 7-16, 18-21, and 33-36 are currently pending. The rejections are as stated below.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1, 2, 7-10, 18, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al., U.S. Patent No. 6,039,250.

Claims 1, 7, 18, Ito discloses an electronic money sending method comprising a payment mediation system sending arrival notification of a payment intention of a sender to a receiver system belonging to a receiver (column 5 lines 6-11), when the payment mediation system receives electronic data relating to a payment intention from a sender system belonging to a sender for every electronic payment (column 4 lines 43-56); and requesting a deposit of funds into a deposit account of a financial institution determined from said electronic data relating to said payment intention (column 5 lines 21-26, and column 6 lines 26-30), said deposit account being identified by the receiver system and provided to the payment mediation system upon receipt of said arrival notification of the payment intention from the payment mediation system (column 6 line 53 – column 7 line 3), said payment mediation system requesting the deposit of funds into said deposit account only when said payment mediation system newly receives electronic data relating to said deposit account from said receiver system within a payment due date or a payment period determined from said electronic data relating to said payment intention for every electronic payment (column 5 line 61 – column 6 line 14).

Ito fails to specifically teach the receiver being a beneficiary and the sender being a social security agency. Furthermore, Ito fails to teach the deposit being made from assets held by the sender.

Examiner notes that the recitation of a social security agency being the sender and the beneficiary being the receiver is intended use, and is not considered to be a distinguishing limitation over the prior art.

While Ito teaches the funds being transferred from the sender to the payment mediation system before receiving the request for a deposit of funds from the receiver, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Ito to include receiving the request for deposit of funds first, then performing the transfer, because Ito teaches refunding the money if the request isn't received within a certain period of time. In order to reduce transaction costs, it would be beneficial for the payment mediation system to wait for the request within the period of time to perform the transfer from the sender to the payment mediation system.

Claim 2, Ito discloses a method for sending electronic money comprising sending arrival notification of a payment intention from a mediator to a recipient identified by a payer (column 5 lines 6-11), when a notification of the payment intention from the payer of funds is received by the mediator (column 4 lines 43-56); and requesting a deposit of funds as indicated by the payer into a deposit account of a financial institution determined from said payment intention (column 5 lines 21-26, and column 6 lines 26-

30) only when a deposit account identification is newly received from said recipient by said mediator within a payment due date or a payment period determined from said payment intention for each payment (column 5 line 61 – column 6 line 14).

While Ito does not explicitly teach the mediator requesting the deposit of funds into said deposit account, the mediator of Ito may be a financial institution, and therefore the “requesting of deposit” would necessarily be performed internally within the financial institution in order to affect the deposit.

Claim 8, Ito teaches receiving electronic data relating to the deposit account identification, and sending electronic data used to check for the existence of a recipient account to the financial system (column 6 lines 23-36).

Claim 9, Ito fails to teach receiving electronic data from the financial institution system indicating existence of the deposit account. Official Notice is taken that transaction confirmations are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Ito to include an electronic message from the financial institution indicating the existence of a deposit account because it is not possible to deposit money into an account that does not exist. Furthermore, it is desirable to know that a transaction is successful.

Claim 10, Ito teaches the payment intention includes a payment amount, a recipient ID, and a payment date (figures 5, 6).

Claims 33, 35, Ito fails to teach the use of user IDs and passwords for use by senders and recipients of funds in the system. In a previous Office Action, Examiner took Official Notice of this feature, noting that the feature was old and well known in the art. Since Applicant did not adequately traverse Examiner's Official Notice, the common knowledge or well known in the art statement is taken to be admitted prior art. See MPEP 2144.03(C). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Ito to include requiring user IDs and passwords from a payer, when establishing a payment intention, and from a payee when receiving the electronic funds, because the increased security provided by these features is desirable in any financial environment.

6. Claims 11-16 are rejected under U.S.C. 103(a) as being unpatentable over Ito, as applied above, and further in view of Smorodinsky, U.S. Patent No. 6,049,786.

Ito fails to teach the use of hash values in the encryption of digitally signed transmissions, storing transactions, along with their hash values, in a database, deciphering incoming transmissions, and verifying their authenticity by comparing extracted hash values with known values from the database. Smorodinsky discloses an electronic bill payment system employing hashes and digital signatures, a biller computer having a database which stores a plurality of complete bills and a respective

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hash which is digitally signed, decrypting digitally signed hashes and comparing them with new hashes to determine whether or not the transmission is authentic (column 2 lines 40-67). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Ito to include the hash and digital signature features of Smorodinsky because the specific implementation of Smorodinsky would provide increased security, which is a desired characteristic of any electronic payment transaction.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito, as applied above, and further in view of Yu et al., U.S. Patent No. 6,067,621.

Claim 19, Ito fails to teach transmitting data to an IC card for authentication, and deleting the data before the IC card is removed. Yu discloses a user authentication system for authenticating an authorized user of an IC card, for the purpose of a secure financial transaction, transmitting an access key to the IC card for user authentication, and deleting the information before the card is removed (column 9 lines 35-53). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Ito to include Yu's teachings of user authentication using an IC card because Ito teaches IC cards, and it is desirable that electronic transactions be secured using any known security protocols.

8. Claims 20, 21, 34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al., U.S. Patent No. 6,039,250, in view of Guitierrez-Sheris, U.S. Patent Application Publication No. 2002/0029190.

Ito fails to teach a status identification field, and newly registering status information when events occur.

Guitierrez-Sheris discloses a system for transferring electronic money wherein the intermediary server maintains a status field (paragraph 43, table 1, "field 52), and wherein the status field is updated periodically to reflect the status of the money transfer, including "open", "expired", "pending", "active" (paragraphs 121, 133, 140, 154). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Ito to include the status updates of Guitierrez-Sheris in order to perform maintenance duties as taught by Guitierrez-Sheris. For example, it is necessary that "expired" transactions be handled in a certain way, and therefore one would desire a way to retrieve all expired transactions, or to determine if a certain transaction has been expired.

Response to Arguments

9. Applicant's arguments with respect to claim 1, 2, 7, and 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

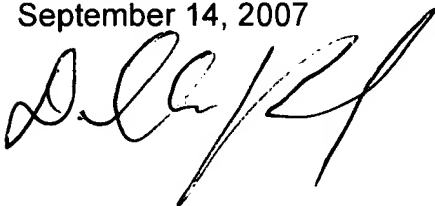
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Dan Kesack
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September 14, 2007



HANI M. KAZIMI
PRIMARY EXAMINER